

REMARKS

Upon entry of the claim amendments presented herein, claims 36-38, 42-44, 46-48, 50, 57, and 60-70 will be pending in the present application. Applicants have amended claim 57 and canceled claims 39-41, 45, 49, 51-56, 58, and 59 without prejudice. Claims 60-70 are new. Support for the new claims can be found in the specification, for example, at page 8, lines 24-29 (and claim 52) for claim 60; and at page 4, lines 8-26 for claims 61-70.

Applicants thank the Examiner for acknowledging that claims 36-38, 42-44, 46-48, and 50 are allowable as written.

Claim Objections

The Office Action objects to claims 40 and 52 as depending from rejected base claims. Applicants have canceled claim 40, thereby obviating the objection to this claim. New independent claim 60 incorporates all of the limitations of claim 52 and the claim from which it depended. Applicants submit that this amendment overcomes the objection to claim 52.

35 U.S.C. § 112 Enablement

The Office Action alleges that claims 39, 41, 45, 49, 51, and 53-59 are not enabled. Applicants have canceled claims 39, 41, 45, 49, 51, 53-56, 58, and 59, thereby obviating the rejection with respect to these claims.

Applicants have amended claim 57 to recite an isolated nucleic acid that encodes a polypeptide, the amino acid sequence of which is at least 99% identical to SEQ ID NO:20 or SEQ ID NO:25, where the encoded polypeptide has an activity of a G protein-coupled receptor protein. Applicants submit that a skilled practitioner could easily, and without undue burden, make and use an isolated nucleic acid that encodes a polypeptide, the amino acid sequence of which is at least 99% identical to SEQ ID NO:20 or SEQ ID NO:25. A skilled practitioner would expect most, if not all, of these encoded polypeptides to exhibit an activity of a G protein-coupled receptor protein, and could easily test these polypeptides for such activity. Applicants respectfully submit that amended claim 57 is enabled and request that this rejection be withdrawn.

Applicants submit that new claims 60-70 are enabled and can be practiced without undue burden. A skilled practitioner could easily test the polypeptides encoded by the nucleic acids of claims 57 and 60 for the ability to bind histamine, as recited in claims 61 and 62. In addition, a skilled practitioner could easily prepare a vector or cultured host cell containing the nucleic acids of claims 57 and 60, as recited in claims 63-66, and produce a polypeptide using the cultured host cells of claim 47, 48, 65, or 66, as recited in claims 67-70.

35 U.S.C. §112 Written Description

The Office Action alleges that claims 39, 41, 45, 49, 51, and 53-59 contain subject matter that was not described in the specification in such a way as to reasonably convey to a skilled practitioner that the inventors had possession of the claimed invention. Applicants have canceled claims 39, 41, 45, 49, 51, 53-56, 58, and 59, thereby obviating the rejection with respect to these claims.

As described above, Applicants have amended claim 57 to recite an isolated nucleic acid that encodes a polypeptide, the amino acid sequence of which is at least 99% identical to SEQ ID NO:20 or SEQ ID NO:25, where the encoded polypeptide has an activity of a G protein-coupled receptor protein. According to Example 14 of the Revised Interim Written Description Guidelines,¹ a claim that recites a polypeptide having at least 95% identity to a disclosed amino acid sequence and a function of the disclosed sequence satisfies the written description requirement. As amended, claim 57 recites that the polypeptide encoded by the nucleic acid of the claim is at least 99% identical to SEQ ID NO:20 or SEQ ID NO:25 and has an activity of a G protein-coupled receptor protein. Since it is even more narrowly drawn than the claim of Example 14 (99% identity as opposed to 95% identity), Applicants submit that this claim amply satisfies the written description requirement. Applicants request that this rejection be withdrawn.

Applicants submit that new claims 60-70 satisfy the written description requirement. The application demonstrates that Applicants were in possession of the subject matter of these claims.

¹ Available at <http://www.uspto.gov/web/menu/written.pdf>

35 U.S.C. § 102(e)

The Office Action alleges that claims 39, 41, 45, 49, 51, and 53-59 are anticipated by Goodearl et al., U.S. Patent No. 5,882,893. Applicants have canceled claims 39, 41, 45, 49, 51, 53-56, 58, and 59, thereby obviating the rejection with respect to these claims.

As described above, Applicants have amended claim 57 to recite an isolated nucleic acid that encodes a polypeptide, the amino acid sequence of which is at least 99% identical to SEQ ID NO:20 or SEQ ID NO:25. Applicants submit that Goodearl et al. does not teach a polypeptide that is at least 99% identical to the amino acid sequence of SEQ ID NO:20 or SEQ ID NO:25. Thus, Applicants submit that Goodearl et al. fails to anticipate claim 57 and request that this rejection be withdrawn.


CONCLUSION

Applicants respectfully submit that the objection to claim 52 and the rejections of claim 57 have been overcome by the amendments and arguments presented herein. Applicants further submit that all pending claims, including new claims 60-70, are in condition for allowance.

Enclosed is a \$120 check for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: December 2, 2005


Janis K. Fraser, Ph.D., J.D.
Reg. No. 34,819 *Reg No 30,125*

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110
Telephone: (617) 542-5070
Facsimile: (617) 542-8906